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09/543,164	04/05/2000	Gregory John Billington	07703-332001	6323

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/543,164

Applicant(s)

BILLINGTON ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8, 10-20, 25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 10-20, 25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in Claim 8, line 7 what the phrase "highest-value further denomination monetary unit" is referring to. Line 3 refers to "at least one further denomination". A "highest-value further denomination monetary unit" appears to be a hundred-dollar bill, or a twenty dollar bill, for example. One further denomination could be construed as a penny or a hundred-dollar bill. Therefore, since the bounds of the "further denomination" appears to encompass both the lower value or higher value, this appears to be at odds with the "highest-value further denomination."

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-20, 25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morun (US 5,566,807). Morun discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (1) *operable* to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further *operable* in response to determining that insufficient change is available (see figure 8, element 900), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 9, element 1002) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount (see figure 7),
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 5, elements (420 and 430));

As described in Claims 8, 17 and 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (95) (see also col. 11, lines 3-24);

As described in Claim 29;

5. the warning indication is provided only if the allowable overpay amount is non-zero (note that the warning indication as described in col. 11, lines 3-24 will not be provided where the customer submits an amount that is the price of the item desired).

As described in Claim 30;

6. said predetermined criterion is met when the available change is less than the value of the lowest denomination non-refundable payment unit (see figure 8);

As described in Claim 31;

7. said vending machine is operable to provide an "exact change" indication to a customer when a requested vend is inhibited (again, note display (95), thereby providing ability and capability to display such information);

As described in Claims 11, 28 and 32;

8. the machine is operable, when inhibiting a vend, to permit the customer to request a vend at a different price (note that the customer is capable of requesting a vend at a different price when the machine becomes disabled (1106)).

As described in Claim 13;

10. the circumstances giving rise to the second indication also cause the deposited monetary unit to be refunded (see figures 10a and 10b);

Art Unit: 3653

5. Claims 8-10, 12, 14-18, 20 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Tedesco et al (US 6,085,888). Tedesco et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (100) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further operable in response to determining that insufficient change is available (see figure 8a, element 820), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see figure 8a, element 822) , depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)
3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 1b, noting processor (144) which necessarily allows input and storage of item prices);

As described in Claims 8, 17 and 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figure 8a, elements (820 and 822));

6. Claims 8-10, 12, 14-18, 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsey et al (US 6,055,521). Ramsey et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (35) operable to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices;
2. a vending machine further operable in response to determining that insufficient change is available (see figures 5, 15a and 15b), either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend, depending on whether the difference between the available change and the correct change is equal to or less than a predetermined allowable overpay amount; (Note that the amount of overpay can be reasonably construed as being that amount in excess of the amount needed to purchase an item, and that said price of said item can be reasonably construed as being a predetermined amount. Therefore, any amount above the item price is predetermined to be an overpay.)

3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (note that PC (27) necessarily allows input and storage of item prices);

As described in Claims 8, 17, 19-20, 25, 27 and 29;

4. the vending machine is operable to provide a warning indication prior to initiation of a transaction if the available change meets a predetermined criterion (see figures 5, 15a and 15b);

7. Claims 8-20, 25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,119,099). Walker et al discloses the vending machine as follows.

As described in Claims 8-10, 12, 14-18, 20 and 29;

1. a vending machine (10) (see col. 3, lines 62 and 63) *operable* to accept payments in units of different denominations, to perform vends, and to dispense change corresponding to the difference between payments and vend prices (note that vending machines are well-known to be able to perform such functions—see also col. 5, lines 35-46 and col. 6, lines 14-30);
2. a vending machine further *operable* in response to determining that insufficient change is available, either (i) to dispense a lesser amount of change or (ii) to inhibit a requested vend (see col. 6, lines 31-44) , depending on whether the difference between the available change and



the correct change is equal to or less than a predetermined allowable overpay amount (see col. 6, lines 45-65),

3. the vending machine has means permitting alteration of a stored parameter defining the predetermined allowable overpay amount (see figure 1a, noting input device (14) and upsell database (30));

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 8-20, 25 and 27-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 8-20, 25 and 27-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255 in view of Morun. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application. In addition, the claims of Morun disclose an overpayment process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 8-20, 25 and 27-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-15 of copending Application No. 09/528,255 in view of Walker et al (US 6,119,099). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scaling factor described in the claims of the '255 patent can be reasonably construed by those ordinarily skilled in the art as the functional equivalent of the "overpayment amount" described in the claims of the present application. In addition, the claims of Walker et al disclose an overpayment process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Response to Arguments**

12. Applicant's arguments filed 6/10/02 have been fully considered but they are not persuasive. *Applicant asserts that a display means arranged to give first and second indications that insufficient change may be available to a customer is not obvious over the prior art. However, it is noted that a "change empty" or "bills only" LED display message is routinely found on vending machines. Note also Walker, cited above, which has an elaborate scheme of warnings and identifications which appear to match applicants' limitations found in the independent claims. Claim 8, for example, recites that a vending machine which accepts units of money in a plurality of denominations dispenses change in at least one of said denominations but not in at least one further denomination." Most vending machines in the U.S. accept money from the U.S. monetary system. This system has denominations which include the penny, nickel, dime, quarter, half-dollar and dollar coins as well as the one, two, five, ten, twenty, fifty, hundred, five-hundred and one-thousand dollar bills. It is noted that "at least one further denomination" is a matter of design choice, determined based upon the circumstances of the vends performed and the prices of the vended products. Some vending machines do not accept pennys, for example. Most vending machines do not accept anything above a five-dollar bill. Since vending machines can be found which do not accept anything above or below at least one further denomination, then it is construed that the cited prior art reads on Claim 8. Claim 20, for example, appears to read on any typical vending machine. For example, the Examiner sits in an office located next to a vending machine made by "National Vending Machine Co." If a change of fifty cents is*

Art Unit: 3653

*inserted, and a product costing sixty cents is selected, the display first displays the credit inserted, fifty cents, then the price of the product, sixty cents. At the same time, the machine emits an audible "beep" twice while the information is displayed. A particular overpay amount could be construed as "zero" in the typical vending machine. However, also note Walker and Morun disclose "overpay amounts" as described above.*

*It is noted that the prior art cited above, Morun and Walker et al in particular, appear to read on the independent claims, as currently written and reasonably broadly construed, as described above. Therefore, the rejection of Claims 8-20, 25 and 27-32 is maintained.*

Regarding the teleconference of 6/3/03, the Examiner apologizes for any inconvenience on the part of Applicants or their Representative. The Examiner was incapacitated and on sick leave due to a serious virus, from Monday, June 2 through at least Thursday June 5. It is believed that Applicant's Representative was contacted upon return to work the next week, however, it was indicated that a response in writing had already been submitted.

Applicants' Representative is encouraged to contact the Examiner to discuss any issues in the case in order to bring this case to allowance.

***Conclusion***

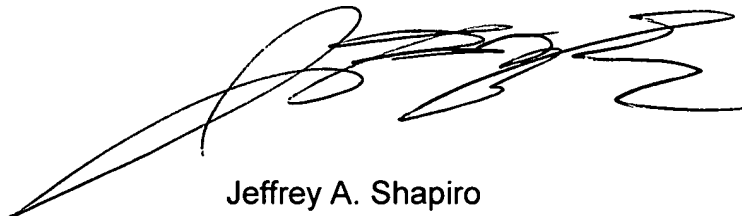
**13. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**14.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

A handwritten signature in black ink, appearing to read 'Jeffrey A. Shapiro', with a long, sweeping horizontal stroke extending to the left.

Jeffrey A. Shapiro  
Examiner  
Art Unit 3653

August 24, 2003

A handwritten signature in black ink, appearing to read 'Donald P. Walsh', with a stylized, cursive script.

DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600